

REMARKS

This Amendment is presented in response to the Office Action mailed October 5, 2004 (the "Office Action"). By this paper, claim 12 is amended, and new claims 33-34 are added. Claims 23-32 have been withdrawn by the Examiner. Claims 1-22 and 33-34 are now pending in the application as a result of the aforementioned withdrawals and new claims.

Reconsideration of this application is respectfully requested in view of the above amendments to the claims and the following remarks.

I. Objections to Claims 5 and 12

The Examiner has objected to claims 5 and 12 stating that "claim 5 recites a 'mounting plate on the upper surface of the substrate' and claim 12 recites 'a mounting plate supporting the substrate.' The same term is used for different structures. Appropriate correction is required."

Applicant respectfully submits that in light of the amendment herein to claim 12, the objection has been overcome and should be withdrawn.

II. Claim Rejections

A. General considerations

As an initial matter, Applicant respectfully notes that the discussion herein should not be construed to constitute an exhaustive enumeration of the distinctions between the claims of the present application and the references cited by the Examiner. Instead, such distinctions are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of

the present application and the references cited by the Examiner, and/or the merits of additional or alternative arguments.

Moreover, Applicant notes that the claim amendments and/or arguments herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. These claim amendments should not be construed as an acquiescence, on the part of the Applicant, as to the purported teachings or prior art status of the cited references, nor as to the characterization of the cited references advanced by the Examiner. Accordingly, Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

B. Obviousness rejections under 35 U.S.C. § 103(a)

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143.

Turning now to the specific rejections, the Examiner has rejected all of the claims, 1-22, under 35 U.S.C. § 103(a) in light of various purportedly obvious combinations of US 6,731,424 to Wu (“*Wu*”), US Pub. No. 2003/0031430 of Jiang et al. (“*Jiang*”), US 6,416,238 to Gilliland et al. (“*Gilliland*”), US Pub. No. 2004/0022476 of Kirkpatrick et al. (“*Kirkpatrick*”) and US

5,848,210 to Kimura (“*Kimura*”). For at least the reasons outlined herein however, Applicant respectfully disagrees with the Examiner.

a. Claims 1-8, 13-16 and 18

The Examiner has rejected claims 1-8, 13-16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Wu* in view of *Jiang*. With specific reference first to claims 1, 4, 6, 7 and 16, the Examiner has asserted that “Wu discloses a package for an optic device comprising: a substrate (214); and an optic device (semiconductor optical amplifier (SOA) chip 136) mounted over the substrate, the optic device having a first port and a second port (Fig. 21),” and concedes that “Wu does not disclose that the package includes a cap that forms a hermetic seal around the optic device and the cap includes a first window and a second window.” The Examiner then concludes that “It would have been obvious to modify Wu to include a cap forming a hermetic seal around the optic device and including windows such as that taught by Jiang in order to provide low-cost smaller package and to seal out contaminants to protect the optic device (i.e., SOA chip) while allowing light to propagate.”

Notwithstanding the characterizations of the *Wu* and *Jiang* references advanced by the Examiner, Applicant respectfully submits that, contrary to the assertion of the Examiner, it is clear that there is no motive to modify the *Wu* device to include the “cap forming a hermetic seal” purported by the Examiner to be taught by *Jiang*. In particular, *Wu* recites a “package housing 210 . . . preferably hermetically sealed to protect the semiconductor amplifier device 136 from the environment.” (col. 17, lines 16-18) (emphasis added). Since *Wu* purports to teach a hermetically sealed semiconductor amplifier, no apparent benefit would be realized by modifying the *Wu* device to include the “cap forming a hermetic seal” of *Jiang*. Moreover, the

Jiang device 202 (or 210) includes only a single window 208 (or 216) (see, e.g., Figure 2B), while claim 1 requires a cap that includes a “first window” and a “second window.”

Thus, although *Wu* fails to teach, as the Examiner has conceded, the claim 1 limitation of a “cap that forms a hermetic seal around the electro-optic device . . . comprising . . . a first window . . . and a second window . . .,” it is nonetheless clear that there is no suggestion or motivation to modify the *Wu* device in the manner that the Examiner has suggested would be obvious. Moreover, even if the *Wu* device were modified to include the *Jiang* device 202 (or 210), it is clear that the resulting combination still fails to include, at least, the “second window” recited in claim 1.

As to claims 2, 3, 5, 8, 13-15 and 18, the rejections of each of those claims is based in part on the purportedly obvious modification of *Wu* to include the “cap forming a hermetic seal” of *Jiang*. As discussed above in connection with claims 1, 4, 6, 7 and 16 however, there is no motive to combine the references in the manner suggested by the Examiner, nor would the resulting combination include all the limitations of the rejected claims. Thus, the rejections of claims 2, 3, 5, 8, 13-15 and 18 are likewise unavailing.

For at least the reasons outlined in the foregoing discussion, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-8, 13-16 and 18. Accordingly, Applicant further submits that the rejection of those claims has been overcome and should be withdrawn.

b. Claims 9-12

The Examiner has rejected claims 9-12 under 35 U.S.C. § 103(a) as being unpatentable over *Wu* in view of *Jiang* as applied to claim 1, and further in view of *Gilliland*. For at least the reasons outlined herein however, Applicant respectfully disagrees with the Examiner.

In particular, and as noted above, the rejection of claims 9-12 is based in part on the purportedly obvious modification of *Wu* to include the “cap forming a hermetic seal” of *Jiang*. As discussed above in connection with claims 1, 4, 6, 7 and 16 however, there is no motive to combine the references in the manner suggested by the Examiner, nor would the resulting combination include all the limitations of the rejected claims. Thus, the rejections of claims 9-12 are likewise unavailing.

c. Claim 17

The Examiner has rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Wu* in view of *Jiang* as applied to claim 1, and further in view of *Kirkpatrick*. For at least the reasons outlined herein however, Applicant respectfully disagrees with the Examiner.

In particular, and as noted above, the rejection of claim 17 is based in part on the purportedly obvious modification of *Wu* to include the “cap forming a hermetic seal” of *Jiang*. As discussed above in connection with claims 1, 4, 6, 7 and 16 however, there is no motive to combine the references in the manner suggested by the Examiner, nor would the resulting combination include all the limitations of the rejected claims. Thus, the rejection of claim 17 is likewise unavailing.

d. Claims 19-22

The Examiner has rejected claims 19-22 under 35 U.S.C. § 103(a) as being unpatentable over *Wu* in view of *Jiang* as applied to claim 1, and further in view of *Kirkpatrick*. For at least the reasons outlined herein however, Applicant respectfully disagrees with the Examiner.

In particular, and as noted above, the rejection of claims 19-22 is based in part on the purportedly obvious modification of *Wu* to include the “cap forming a hermetic seal” of *Jiang*. As discussed above in connection with claims 1, 4, 6, 7 and 16 however, there is no motive to combine the references in the manner suggested by the Examiner, nor would the resulting combination include all the limitations of the rejected claims. Thus, the rejection of claims 19-22 is likewise unavailing.

III. New Claims 33-34

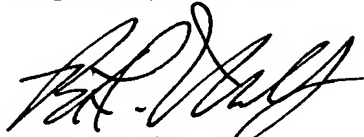
Applicant has added new claims 33-34 herein. As each of the new claims depends from claim 1, believed by the Applicant to be in condition for allowance, Applicant respectfully submits that new claims 33-34 are likewise in condition for allowance.

CONCLUSION

In view of the remarks and amendments submitted herein, Applicant respectfully submits that each of the pending claims 1-22 and 33-34 is now in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of such claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 22nd day of December, 2004.

Respectfully submitted,



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